



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/304,481	09/22/81	KOBREHEL	G BA-157

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EXAMINER	
CHAN, N	
ART UNIT	PAPER NUMBER
123	10
DATE MAILED:	12/09/83

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined.

Responsive to communication filed on 10-6-83

This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892 2. Notice of Informal Patent Drawing, PTO-948
3. Notice of References Cited by Applicant, PTO-1449 4. Notice of Informal Patent Application, Form PTO-152

Part II SUMMARY OF ACTION

5. 2-11 + 23

1. Claims 2-11 + 23 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims _____ have been cancelled.

3. Claims _____ are allowed.

4. Claims 2-11 + 23 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. The formal drawings filed on _____ are acceptable.

8. The drawing correction request filed on _____ has been approved. disapproved.

9. Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has
 been received. not been received. been filed in parent application, serial no. _____,

filed on _____.

10. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

11. Other

Art Unit 123

Claim 23 is rejected under 35 U.S.C. 112, first paragraph, as the disclosure is enabling only for claims limited in accordance with the disclosure at the bridging paragraph of pages 3-4 of the specification. See MPEP 706.03(n) and 706.03 (z).

While it is true that the specification does not have to exemplify every claimed compound, the fact remains that the specification is not enabling with respect to the compound wherein only R₂ is hydrogen. The specification specifically teaches that acylation of the N-methyl compound (the compound of Example 1 and claim 2) will produce a compound wherein R₂ is acyl. There is no teaching of how to prepare the compound wherein only R₂ is hydrogen and at least one of R₃ and R₄ is acyl.

Claims 2-11 and 23 are rejected under 35 U.S.C. 103 as being unpatentable over Kobrehel et al, of record, for reasons set forth in paper No. 8.

Applicant's arguments filed October 6, 1983 have been fully considered but they are not deemed to be persuasive.

Although the reference fails to teach the N-methyl compound, replacing an amine hydrogen by a methyl group is an obvious modification. See In re Paunette, 165 USPQ 317, 319. If Applicants intend to show unobvious and superior properties of the claimed compound, side-by-side comparisons with the 11-aza-10-deoxo-10-dihydro erythromycin A (and not erythromycin A per se) must be presented.

Art Unit 123

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Chan:srb

A/C 703

557-3920

12/7/83



NICKY CHAN
PRIMARY EXAMINER
ART UNIT 123